



UNITED STATES PATENT AND TRADEMARK OFFICE

JUN -6 2007

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MINTZ LEVIN COHN FERRIS GLOVSKY
AND POPEO, PC
1400 PAGE MILL ROAD
PALO ALTO, CA 94304-1124

In re Application of :
Gregory Breyta et al :
Serial No.: 10/729,453 : PETITION DECISION
Filed: December 4, 2003 :
Attorney Docket No.: ARC920030074US1 :

This is in response to the petition under 37 CFR 1.144, filed March 30, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on December 4, 2003, and contained claims 1-74 (pages 48-85). In a first Office action, mailed October 12, 2006, the examiner required restriction between the inventions claimed, as follows:

- Group I – claims 1-14 and 70, drawn to an aliphatic fluorinated polyol;
- Group II – claims 15-27 and 71, drawn to an aliphatic fluoroalkanol ester;
- Group III – claims 28-35, 39 and 72, drawn to a cycloaliphatic fluoroalkanol ester;
- Group IV – claims 36-38, 40-43 and 73, drawn to a fluordihydroxy ester;
- Group V – claims 44 and 74, drawn to a fluortrihydroxy ester;
- Group VI – claims 45-49, drawn to a method of making Group I compounds;
- Group VII – claims 50-56, drawn to a method of making Group II compounds; and
- Group VIII – claims 57-69, drawn to making Group IV or V compounds.

The examiner reasoned that the compounds of Groups I-V were drawn to patentably distinct compounds. Groups VI - VIII were defined as process claims related to, but distinct from the product claims. Advisability of rejoinder of non-elected method claim with allowable product claims was set forth. The examiner reasoned that the different classifications and scope of the product claims posed an undue burden on the Office.

Applicants replied on November 13, 2006, electing Group II with traverse with respect to Groups II-V and VII-VIII only. Applicants argued that there is no undue burden to the search and examination of all of these groups of claims

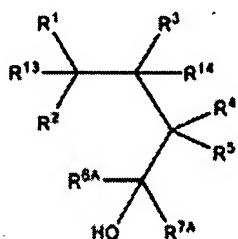
The examiner mailed an ex parte Quayle Office action to applicants on February 7, 2007, and remailed the action on February 23, 2007, correcting the time period for reply. The action indicated that the elected claims, 15-27 and 71 and the corresponding rejoined method claims, claims 50-56, were allowable and requested cancellation of all other non-elected claims. The examiner did not directly respond to applicants' traversal of the restriction requirement.

This petition was filed on March 30, 2007, traversing the restriction requirement as being in error.

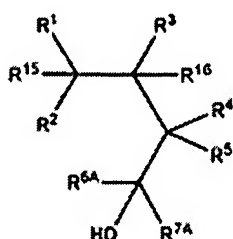
DISCUSSION

Applicants' petition is directed primarily to the restriction between compound Groups II-V and is based on similar structural elements and significant overlap of the compounds encompassed within the claims thus showing that the Groups are not distinct from each other, but also addresses the restriction between Groups I and II.

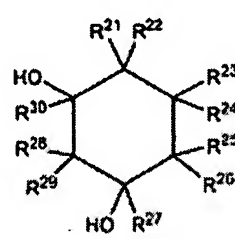
Claims 1, 15, 28, 36, and 44 are independent claims directed to various basic compound structures. (Claims 70-74 are also independent claims, but directed to specific narrower embodiments of the basic claims.) The basic structures are represented by formulas IV, V, VII, VIII and IX, as shown



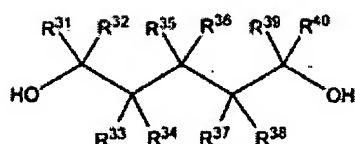
IV



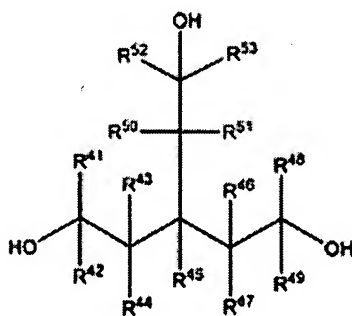
V



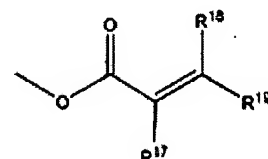
VII



VIII



IX



VI

Applicants first argue that Groups II-V all have in common ester structure VI (shown above) as a substituent (as R¹⁵ or R¹⁶, R²³ or R²⁶, R³⁶ or R³⁷, and R⁴⁵ or R⁴⁶) which is located in each structure 2 or 3 carbons distant from the hydroxyl group. However, restriction is not based on substituents or their location, but a common core. Here there is a carbon backbone in each

structure, but the backbones differ in that V is a 4-carbon chain with a terminal hydroxyl, VII is a cyclized 6-carbon ring with two hydroxyl groups, VIII is a five carbon chain with two terminal hydroxyl groups and IX is a branched 7-carbon trihydroxy structure. Thus each backbone is unique and the subject of a separate search. That is search for a diol or triol would not be the same as for a mono-ol.

Applicants further argue that claims 15, 36 and 44 significantly overlap based on R^1 in claim 15, when compared with $CR^{39}R^{40}OH$ in claim 36 (and similarly with claim 44). However, careful consideration of the numerous possibilities appears to show that overlap is avoided between the claims. Further, claim 15 does not appear to provide for branched structures.

Applicants also argue that claim 28 does not overlap in scope with the other claims, but is related to them in that it is a cyclized version of structure VIII. While this may be so, the structures will have different properties and be searched differently. (One would not search for a ring structure among non-cyclic structures or conversely.)

In view of the above the restriction between Groups II-V is seen as proper since there is no common core. Although applicants argue that there is overlap between the Groups, such overlap, if it exists, is based on a specific substitution in claim 15 of R^1 and modification of some other substituents (as stated by applicants). This does not suggest true overlap, but close relationship only.

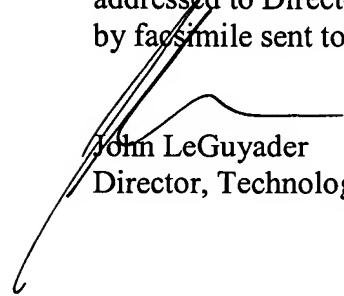
Although not previously traversed, applicants then argue that Claim 1 and Claim 15 are of a similar structure only that substituents R^{13} and R^{14} are different and no ester structure of Group VI is included in the substituents. Applicants are correct in showing that the backbone structures are the same. Based on this, Groups I and II are not distinct except in their substitutions and it would appear should not have been restricted from each other. However, since one is characterized only as a polyol and the other as requiring an ester structure, restriction was proper.

DECISION

The petition is **DENIED** for the reason set forth above.

Applicants remain under obligation to reply to the Office action mailed February 23, 2007, within the time period set therein or as extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.


John LeGuyader
Director, Technology Center 1600